

REMARKS

Upon entry of the forgoing amendments claims 52-53 are pending in the application. Claim 1-51 have been cancelled without prejudice or disclaimer to the subject matter claimed therein. The amendment does not introduce any new subject matter within the meaning of 35 U.S.C. §132. Therefore, entry of the amendments is respectfully requested.

**REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

The Examiner has rejected claims 45, 46, 48 and 51 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The rejected claims recite the phrase "active ingredient" which the Examiner has stated lacks antecedent basis. Applicants respectfully submit that claims 45, 46, 48 and 51 have been cancelled, thereby removing the basis for this rejection. Furthermore, newly added claims 52-54 do not contain the rejected phrase and therefore are clear and definite within the meaning of 35 U.S.C. §112, second paragraph.

Claims 45 and 46 are further rejected as reciting the phrase "the substance is directed against". Applicants respectfully submit that claims 45 and 46 have been cancelled, thereby removing the basis for this rejection. Furthermore, newly added claims 52-54 do not contain the rejected phrase and therefore are clear and definite within the meaning of 35 U.S.C. §112, second paragraph.

Based upon the foregoing, Applicants submit that the basis of these rejections has been removed in light of the cancellation of the rejected claims. Newly added claims 52-54 are definite and particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Therefore, the Examiner is respectfully

requested to reconsider and withdraw these rejections.

**REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

The Examiner has rejected claims 25, 45, 46, 48, 50 and 51 as failing to comply with the written description requirement as containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

These claims are rejected because they are inclusive of multiple genera of peptides, while Examiner states that the specification only reasonably conveys peptides that comprising antibody fragments that specifically bind proteins listed in Table 1. Applicants respectfully submit that claims 25, 45, 46, 48, 50 and 51 have been cancelled. Furthermore, newly added claims 52-54 are directed to peptides disclosed in Table 1, thereby complying with the written description requirement.

These claims are further rejected because the Examiner states that the specification does not reasonably provide enablement for a method for diagnosing just any disorder associated with just any type of tumor by contacting eukaryotic cells with just any peptide which detects the expression or function of just any protein synthesized or secreted by tumors. Applicants respectfully submit that claims 25, 45, 46, 48, 50 and 51 have been cancelled.

Furthermore, newly added claims 52-54 are directed to a method for diagnosing disorders associated with prostatic carcinomas, wherein eukaryotic cells are brought into contact with a peptide which detects the expression or the function of proteins synthesized or secreted by tumors, wherein the proteins are selected from the group consisting of sialic acid synthase and KNP1-beta, and are synthesized by prostatic carcinomas. Applicants submit that these proteins are disclosed in the specification as being more abundant in cancerous tissue. See, for example, Table 1. As such new claim 52-54 are enabled.

Based upon the foregoing, Applicants submit that the basis of these rejections has been removed in light of the cancellation of the rejected claims. Newly added claims 52-54 comply with the written description requirement and are properly enabled. Therefore, the Examiner is respectfully requested to reconsider and withdraw these rejections.

**REJECTION UNDER 35 U.S.C. §102 (b)**

The Examiner has rejected claims 25, 45, 46, 48, and 51 as being anticipated by Blankenberg, et al. (PNAS, 5/98, 95: 6349-6354).

Applicants respectfully submit that claims 25, 45, 46, 48, and 51 have been cancelled. Furthermore, newly added claims 52-54 are directed to the subject matter previously claimed in claim 50, i.e., prostatic carcinomas, which is not subject to the instant rejection.

Based upon the foregoing, Applicants submit that the basis of these rejections has been removed in light of the cancellation of the rejected claims. Newly added claims 52-54 are not anticipated by Blankenberg, et al. (PNAS, 95: 6349-6354). Therefore, the Examiner is respectfully requested to reconsider and withdraw these rejections.

**CONCLUSION**

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the requirement for claim restriction and election of species and examine all claims pending in this application.

If the Examiner has any questions or wishes to discuss this application, kindly telephone the undersigned at the below-listed number.

Respectfully submitted,

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